

No. 20750

In the
United States Court of Appeals
For the Ninth Circuit

M.O.S. CORPORATION, *Plaintiff-Appellant*,

vs.

JOHN I. HAAS, INC., *Defendant-Respondent*

BRIEF OF APPELLANT

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF WASHINGTON,
SOUTHERN DIVISION

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The findings and judgment from which this appeal is taken are found on pages 68-85 of the Transcript of Record.

JURISDICTION

The appellant—plaintiff below—is a corporation organized to do business in the State of Washington. The defendant-respondent is also authorized to do business in the State of Washington. This Court has jurisdiction in the present action because it arises under the Patent Laws of the United States (28 U.S.C. § 1338, 1391, 1400).

STATEMENT OF THE CASE

This case was before this Court as Case No. 18953. The issues tendered to the Court in that case were

whether or not the plaintiff was precluded from prosecuting this action by virtue of the doctrine of file wrapper estoppel. At the first trial of this cause it appeared that after the issuance of the patent in question, being patent No. 2,674,535 (Ex. 1), which was issued April 6, 1964, the inventor filed an application for reissue of the patent, which application was not timely filed. It was rejected by the Examiner upon two grounds, namely failure to file on time and on the further ground that the application contained *new matter*. The Trial Court at the conclusion of the first trial found that the doctrine of file wrapper estoppel applied and the plaintiff-appellant could proceed no further. This Court reversed, holding that the doctrine did not apply for the reason that, although the inventor, Sidney S. Meisler, in his application for reissue stated that the single drum application of his invention was omitted from the claims of the above-mentioned patent, being Exhibit 1 herein, by mistake and inadvertence, and that the double drum application of this patent disclosed in his patent and claimed in the patent was intended to, but did not cover the single-drum application, nevertheless this was a conclusion and not binding under the circumstances, and the question of infringement should be decided on the merits.

The patent in question relates to a method of preparing and packaging hops for shipment principally in the export trade. The testimony in the case established that

the hop industry in the Western states—where approximately 90 per cent of all hops produced in the United States are grown and 80 per cent of this in the Yakima Valley—was commenced about 1880 or 1890; that in the Western states the practice soon developed of baling the hops on the ranch, delivering the baled hops to the broker's warehouse or buyer's warehouse, from whence they were shipped to market. This market was largely within the confines of the United States due to the fact that hops thus baled could not be adequately protected when shipped abroad. The hops would acquire various odors from other materials which were either on board or had previously been shipped, thus contaminating the hops and rendering them undesirable from the standpoint of the buyer. (R. 63, et seq., prior case)

Commercial hops are the cone produced by the hop vine. The vines grow in open fields on trellises from 10 to 20 feet in height, and at the end of the growing season are harvested by cutting the vines near the ground and removing the vines together with their cones to a picking machine or to pickers from whence the cones are removed from the vines, either by hand or by machine, and placed in a building in large containers through which warm air is blown for the purpose of removing moisture. Dry hops come from these bins with a relatively small amount of moisture. The cones are to some extent shattered. In order to put the cones in a suitable condition for transportation they are

placed in burlap and mildly compressed with a pressure great enough to cause the leaves of the cone to adhere to one another but not enough to break the cells and expose the lupulin to the air. Exposure of the lupulin to the air causes its contamination and deterioration, rendering the product unfit for use. The lupulin is the essence of the hop cone of value in the brewing process. It serves two functions, it gives a flavor and it imparts a preservative quality to the brew. In the history of the beer industry or art no substitute has ever been found for the lupulin of the hop. As stated, the hop cone and the shattered leaves of the cone are mildly compressed in burlap wrapping at the ranch or farm. Historically it has been convenient for the farmer to create a package approximately 60 inches long by 20x30 inches, weighing approximately 200 pounds. Due to the varying amounts of moisture of the hops, of the particular block of hops from which the cones are taken, no one bale has an identical weight with any other bale. These bales are conveniently stored in warehouses in this oblong condition and because of this convenience the equipment of the farmers throughout the Western States has been uniformly devoted to the production of this type of bale. However, this particular type of bale, due to a lack of density occasioned by the press at the farm and due to the coarseness of the burlap wrapping permits the permeation of deleterious odors and dusts making it unsuitable for shipment abroad. (R. 63 et seq., prior case)

Down through the years various methods have been attempted in an effort to secure an economic package which could be shipped overseas so that the hops are impervious to the deleterious effects above described. None of these efforts have been successful until the Meisler invention, Exhibit 1, patent No. 2,674,535. An effort was made to prepare wooden boxes lined with lead, the size of the original farm bale, inserting the bale within the box and sealing the lid by hand-soldering. This proved impractical due to the expense and due to the difficulty of securing a perfect seal. Efforts were made to use paper bags and plastic bags without practical success, so that at the time of the Meisler invention there was very little trade abroad. With the advent of the Meisler invention, however, trade abroad has significantly increased and a substantial part of the production of hops is shipped abroad to South America, to the Orient and to Europe, utilizing the Meisler invention. (R. 150 et seq., prior case)

The Meisler invention, which has changed the economy of the hop industry, permitting the raising of substantially more hops in the Western States than had ever been raised before, consists of *recompressing* the farm bale to a specially formed elliptical or circular size so that the same can be inserted into standard steel containers. (R. 63 et seq., 115 et seq., prior case)

Claim 1, which is the claim involved here, reads as follows:

“A method for shipping hops comprising the steps of compressing at least *one bale of hops* of rectangular cross section into a *bale of circular cross section*, fastening the bale of circular cross section with spaced flexible members disposed transversely there around, placing the bale of circular cross section into two steel drums with the flanges around the open ends thereof superposed, and sealing the superposed flanges of *the drum*.

For a short period after issuance of the patent, the defendant-respondent, John I. Haas Inc., delivered hops to the plaintiff-appellant in the form of bales to be recompressed and sealed in standard steel drums. Part were re-delivered to the respondent, sealed in two drums, while part were sealed in so-called single drums (R. 86, 87, prior case). In the former case the two drums were sealed at their open ends while in the latter case a lid was applied. Subsequently the representatives of the defendant-respondent examined the operation of the press and the dies between the jaws of the press, and shortly thereafter began using identical dies, see Exhibit 2, without paying any royalty or pursuant to any royalty agreement with plaintiff, the holder of the Meisler patent, by assignment, Exhibit 63. Shortly thereafter this action was instituted, claiming infringement of Exhibit 1, Patent No. 2,674,535. (R. 82 et seq., prior case)

The Trial Court, at the conclusion of the first trial, in his oral opinion, which became the findings of fact by adoption, stated as follows (R. 501 et seq., prior case) :

“* * * were we interpreting the original patent as issued without reference to the reissue application, it might be permissible to construe Claim 1 as reading upon the accused package now used by Defendant. Unfortunately for the Plaintiff and Mr. Meisler, the patentee, it appears to me they have foreclosed a more liberal interpretation of this patent by virtue of said application for reissue wherein it was sought to broaden the language of the claims to include a single drum container. * * *

“The reissue application was rejected on the ground that it contained new matter.

“The patentee or his assignee did not appeal, although counsel for Plaintiff now indicates it may have been fruitless because of possible late filing.

* * *

“By failing to appeal * * * plaintiff, in my judgment, may not now contend that the claims of the original application and patent are susceptible of an interpretation that they cover single drum containers as well as two-drum containers.

“The doctrine of file wrapper estoppel seems applicable and controlling.”

This Court reversed the holding of the Trial Court as stated, and remanded the case for further proceedings, holding that the doctrine of file wrapper estoppel did not apply here, and that the issues tendered by the pleadings should be resolved on their merits without foreclosing the patentee from showing the broader ground covered by Claim 1 notwithstanding the doctrine of file wrapper estoppel. In other words, this Court held that the single drum application might well be an infringement of appellant's patent and the mere fact that the appellant had contended and stated and sworn under oath in the reissue application that the

original claim inadvertently did not cover the single drum application, the appellant was nevertheless entitled to show, which he did show, that that statement was merely a conclusion of his lawyer and did not constitute an admission of fact as to the single drum application. The Trial Court, upon the case being remanded and permitting the introduction of expert testimony concerning the issue involved, ultimately based his decision upon all of the evidence both in the first trial as well as the second trial. (Cause No. 18953)

In the testimony of Robert W. Beach, who testified as an expert, there is found a very clear statement of appellant's position. In qualifying himself Mr. Beach stated. (R. 44)

"I graduated from the University of Washington with the degree of B.S. in aeronautical engineering in 1932, thereafter attended the University of Washington Law School and graduated in 1936 with the degree of Juris Doctor. From May 1937 to February 1938 I was an Examiner in the United States Patent Office in Division 14 examining subclasses in Class 29 pertaining to processes relating to the manufacture of various special articles including automobile wheels, railroad car wheels, railroad tracks, jewelry, propellers, horseshoes and and other types of articles involving metal-working steps.

"From February 1938 to December 1939 I was patent counsel for Atlantic Casting and Engineering Corporation, Clifton, New Jersey.

"I have had * * * extensive practice in prosecuting patent and trademark applications before the United States Patent Office and the Patent Office Board of Appeals."

In analyzing the evidence in the case at bar Mr. Beach testified: (R. 46)

“In the case of an invention involving a combination, a patent will not be granted if the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains, as specified in the Statute 35 USC 103.

“In claims defining mechanical processes the manipulative steps are the important features of the claim rather than the apparatus used in performing the process. * * *

“I have had these factors in mind in considering the question of infringement of claim 1 of the Meisler patent 2,674,535 by the process used by the defendant.

“The process which the defendant in this action uses has been stated to involve the following steps:

‘Cutting a bale of hops generally midway between its ends into two parts,

‘Superimposing the two parts of the bale, each of which is of approximately square cross section in a press and, by the application of pressure by the press, recompressing the bale parts to approximately twice the density of the original bale and reforming the bale parts from stacked doublesquare cross section into a single circular cross section,

‘Bending the recompressed hops to retain the circular cross-sectional shape,

‘Placing the recompressed and banded package into a 55-gallon metal drum,

‘Sealing the cover on the drum end.’ * * *

“In considering the application of claim 1 of the Meisler patent quoted above to the process of the defendant described above, it should be noted that the claim is not limited to any particular type of

bale as long as it is of rectangular cross section. It could be a large bale or a small bale, a long bale or a short bale, a firm, compact, high-density bale or a looser, softer bale. The claim is not limited to use of any 'standard' bale or bale of any particular dimensions. Consequently, the 'bales' placed in the press by the defendant are 'bales' within the terms of the claim, even though such 'bales' may not have any wrapper on them and even though they may have been produced by cutting a larger bale to a smaller size. Such an additional step does not alter the character of the articles processed by the defendant as being 'bales' within the terms of claim 1 of the Meisler patent. The number of 'bales' used in producing the recompressed bale of the Meisler patent claim will depend upon the original density of the bales to be recompressed, the final density desired, the shape and size of cross section of the bale components being recompressed and the desired diameter of the resulting bale of circular cross section. * * *

"Claim 1 of the Meisler patent mentions the container as being composed of two steel drums having superposed flanges, but there is no description in the specification of the patent that the drums of which the container is made must be of special construction, but, on the contrary, it is desired to use 'standard' containers in the process.

"It should be noted that the process does not recite placing one end of the circular cross section bale in one container or drum and placing a second container or drum over the other end of the bale. It is simply required as a practical matter that the steel container of circular cross section be of a size in cross section to receive the recompressed bale and that the length of the container be sufficiently great to receive the bale. Whether the container is made in two parts of equal or in two parts of unequal length, even to the extent that one of such parts is simply a flat cover, is immaterial as far as the packaging process recited in the claim is concerned. The dimensions of the container, the number of parts

of which the container is made, the arrangement of the parts or what parts of the container are sealed have no bearing on the manipulative steps defined by the process claim 1. * * *

“The essential feature of the process defined in claim 1 of the Meisler patent is the densifying of the initial bale components by recompression and, during such recompression, conversion of the bale from a rectangular cross-sectional shape to one of circular cross-section. * * * Since the container in which the recompressed and reshaped bale is finally place for shipping purposes is conventional and the benefits of the process do not depend upon utilizing a container of any particular construction, the mention of two steel drums and drum flanges in the claim does not make such structural features limitations on the method defined by the claim.

“No claims of the Meisler patent application resulting in patent 2,674,535 specifying that the container should have a unitary cylindrical wall extending from end to end of the recompressed and reshaped hop bale was cancelled or restricted * * *. Even if the type of container recited in this claim should be considered a ‘limitation’, therefore, the container used in the defendant’s process should be interpreted as being the equivalent of the two-drum container recited in claim 1 of the Meisler patent in determining the question of infringement.”

Notwithstanding the foregoing clear statement that the single drum application of appellant’s invention is an infringement of the so-called double-drum application, the Trial Court held that the defendant-respondent’s process did not infringe or read upon the patent, Exhibit 1. The Trial Court did not hold the patent invalid although it was invited to do so by respondent. The findings signed by the Court were proposed by respondent (Tr. 64). An examination of these findings

indicates that the Trial Court did indirectly what this Court previously held that it should not do, namely, apply the doctrine of file wrapper estoppel. Thus in the findings we note the following:

“XIX. On May 18, 1956, Meisler, after conferring with his attorney, and with the consent of the plaintiff, M.O.S. Corporation, filed an application for reissue of his patent. The reissue application included claims 1-9 of the patent, and a new claim 10, broadening the last two steps of claim 1 in the following language:

‘placing the bale of circular cross section into at least on drum and sealing said drum.’

The specification was broadened similarly by stating the bale was hermetically sealed ‘in one or two steel drums’ instead of ‘in two standard steel drums’ (Exhibit 14).

“XX. In the Oath accompanying the application for reissue, the patentee, Meisler, said:

“* * * I verily believe the original patent to be partly inoperative or invalid for the reason that the original patent describes my invention as a combination of a method of compressing hops with the step of placing a bale into two steel drums, while actually one steel drum can be used in place of two steel drums without affecting the scope of my invention.

“XXI. The reissue application was rejected on October 19, 1958. The examiner held the application to be defective ‘in that new matter has been introduced into the case * * * wherein the terms “one or” have been inserted. No reference was made in the original specification or claims to the use of one drum for shipping hops.’ (Exhibit 14, page 20).

“XXII. On September 13, 1956, Meisler, by his counsel, requested reconsideration of the examiner’s rejection of the reissue application and urged

that 'the original application contains data from which it is apparent that two drums can be used in lieu of one drum,' and that 'the use of one or two drums is inherent in the original specification' (Exhibit 14, page 22.

"XXIII. On October 19, 1958, the examiner rejected Meisler's reissue application. Thereafter, Meisler abandoned the reissue application."

It is evident from the foregoing that the Trial Court was still being influenced by the doctrine of file wrapper estoppel and did not examine the claim on its merits as directed by this Court, but relied heavily on the legal conclusions prepared by his attorney and signed by Meisler in connection with his reissue application. While the conclusions contained in the file wrapper are aids, they, of course, should not take the place of physical facts to the contrary. It would seem that the initial comment of the Trial Court at the conclusion of the first trial, namely that the process of the defendant could be construed to read upon appellant's claim 1 but for the doctrine of file wrapper estoppel has not truly been abandoned by the Trial Court--thus indirectly applying the doctrine.

QUESTIONS PRESENTED

Did the method of recompressing hops from rectangular bales to bales circular in form, inserting same in a standard steel drum and sealing same with a lid, infringe upon the process claimed in Exhibit 1?

SPECIFICATION OF ERRORS

1.

The court erred in entering its judgment of dismissal (R. 85) and its order denying motion for new trial (R. 86-89).

2.

The court erred in entering its memorandum decision, including findings of fact and conclusions of law (R. 68).

3.

The court erred in holding that the respondent's process of packaging hops did not infringe upon appellant's patent (R. 84).

4.

The court erred in finding that the file wrapper history showed that it was the intention of both the applicant and the examiner that the double drum process was essential to appellant's patent, Exhibit 1 (R. 73, 74).

5.

The court erred in holding that the appellant's patent, Exhibit 1, was preceded by many patents in the field and that therefore it occupied a narrow "crevasse" (R. 72).

6.

The court erred in holding that respondent's single drum process with the added net weight feature did not utilize the steps of appellant's process patent or

method patent and therefore did not infringe same (R. 82, 83).

7.

The court erred in holding that the doctrine of equivalence did not apply to protect appellant's patent against the method of respondent (R. 87).

8.

The court erred in entering findings of fact 9, 12, 14, 15, 16, 21, 22, 25, 26, 27, 28, 29, 32, 33, 34 (R. 77-83), and conclusions of law 3, 4, 5 and 6 (R. 84).

The foregoing specification of errors are predicated upon the following grounds and reasons:

1. The prior art does not narrow the scope of Claim 1 of the patent, Exhibit 1.

2. The file wrapper history does not show that the appellant's method is limited to the use of two drums.

3. The application for reissue and the file wrapper history thereof does not show that the appellant admitted that the scope of its patent was limited to the use of two drums.

4. The essential steps in appellant's patent are included in respondent's process, and therefore there is infringement, even though respondent's process may be less efficient or have added features, i.e., net weight.

5. Respondent's process is the equivalent of appellant's patent.

6. Respondent's process infringes appellant's patent, Ex. 1.

INTRODUCTION

Each of the grounds above cited is applicable to each of the specifications of error and all relate to the basic question whether or not the so-called single drum net weight process of the respondent infringes appellant's patent. Therefore, rather than duplicate the argument in support of each specification of error, it is stated at this point that each of the following subdivisions of argument is applicable to each specification of error. As pointed out hereinafter, the question involved here is the interpretation of Claim 1 of the patent. Under the cases hereinafter cited this is a question of law. Although we disagree with a number of the findings of fact, this relates primarily to the question of the scope of the claim, and under the authorities are reviewable by this court.

ARGUMENT

I

The Scope of the Patent

As set forth above, the patent, Exhibit 1, herein involved was applied for on July 13, 1951 and was issued on April 6, 1954. The claim involved in this controversy is Claim I thereof which reads as follows:

“A method for shipping hops comprising the steps of compressing at least *one bale of hops* of rectangular cross section into a bale of circular cross section, fastening the bale of circular cross section with spaced flexible members disposed transversely therearound, placing the bale of circular cross section into two steel drums with the

flanges around the open ends thereof superposed, and sealing the superposed flanges of *the drum*.” (Italics supplied)

It is the contention of the appellant that this claim does not limit the process patented to the so-called double drum application illustrated in the specifications. As a matter of fact, the last paragraph of the specifications clearly indicates to the contrary. For there it is stated:

“It is obvious that the method and means illustrated and described herein are subject to many variations and modifications within the scope of the appended claims.” (Ex. 1)

It is also significant, we submit, that Claim I refers to utilizing “at least one bale of hops” and that in sealing it is “the superposed flanges of *the drum* that are sealed. As a matter of fact, the degree of compression described in the specifications would clearly dictate the use of a *single drum* with the use of *one bale* of hops, as described in Claim I. (See line 2, column 3 of the specifications (Ex. 1) in which the volume of the bale is indicated to be reduced to 14.5 cu. ft. from the original size of 60x22x30 inches of each original bale which by computation is approximately 22 or 23 cu. ft.) Therefore, Claim I clearly contemplates the use of one as well as two or more drums.

It is, we submit, of significance that the original Claim I included in the original application for patent was never withdrawn or modified in order to secure the issuance of the patent (Ex. 14A). As revealed by

the file wrapper, the Examiner in acting on the original application rejected Claim I as he rejected all claims of the original application. This, of course, under Patent Office practice does not constitute a rule or decision in the judicial sense but merely the contention of one opposing the issuance of patent. (The Examiner thus occupies two positions, that of an adversary resisting the issuance of a patent and finally the judge ruling as to whether the patent should issue or not. It is the final action of the Examiner that constitutes what may be described as a judicial process. His actions prior to that time are necessarily that of an adversary.) After this rejection, it is interesting to note, that the attorney for the applicant responded with rather a short letter, subsequent to which Claim I was allowed. The Trial Court adverted to a portion of the file wrapper in arriving at its conclusion; but we wish to call your Honor's attention to the following:—

The court in its findings after commenting that Claim I had been rejected initially on the grounds that it was old in the art of packaging hops by vacuumizing the containers and admitting an inert gas and that it was found to be immaterial whatever shape the hops were pressed into and that it made no difference whether the container was sealed in the center or the end, stated that the applicant, through his attorney, nevertheless redrafted Claims 9 and 10 and in response to Examiner's rejection of Claim I asked that he reconsider his statement that "it is immaterial what shape

the hops are pressed into" since an important part of "applicant's inventive conception is to be found in the fact that two ordinary rectangular bales of hops are compressed into a single rectangular bale* * *." The court went on to say that the Examiner paid heed to these representations of the applicant in accepting Claims 1 to 5 (R. 73). We think that the remark of the applicant's attorneys of real significance and the one that caused the claim to be allowed was the comment that the *prior art disclosed by Schoonmaker did not anticipate the idea of this patent*. The applicant's attorney stated the following (Ex. 14-A, p. 18) :

"The container of Schoonmaker is a single rectangular container as compared with applicant's *conventional drums*, and the container of Passarelli is a single drum of *other than conventional design* as compared with applicant's *conventional drums* secured end on end."

It is evident that the Schoonmaker container was rectangular and the Passarelli container was a drum of other than conventional design compared with applicant's conventional drums.

Furthermore, the entire paragraph, a portion of which only is set forth by the Trial Court, reads as follows (Ex. 14-A, 17, 18) :

"The Examiner is further requested to reconsider the statement that it is immaterial what shape the hops are pressed into since an important part of applicant's concept is to be found in the fact that two rectangular bales of hops are pressed into a single circular bale, *the diameter of which is always uniform so that it can be readily used with any of the steel drums found in the open market*.

However, applicant has disclosed a way for the elimination of the known custom built metal lined goods for shipping hops which substantially reduces the cost of packaging, storing and shipping". (The italicized words were omitted in the court's findings). (R. 73)

The applicant's attorney was thus — as any good lawyer should—basing his contention on a number of valid propositions. It is clear that the inventive idea relates directly to the results to be achieved; namely, the elimination of the expensive lead lined boxes and the utilization of an inexpensive standard container. Thus, it was necessary to conform the existing bale as it came from the farm to the size of such readily available container. The Examiner himself did not specify upon which ground he was allowing Claim I. Certainly he said nothing to indicate that he was allowing it on the ground that a double drum was something new and different and unobvious. The thing that was new, different and unobvious here and which became commercially successful was the idea of recompressing the unique Western farm bale into a circular form to an extent and manner not to damage the hops or expose the lupulin to the oxidizing effect of the air and to arrive at a shape easily packaged and sealed in existing conventional containers.

The essence of the process described in Claim I may be analyzed as follows:

Step 1: The recompressing of at least one standard bale.

Step 2: Into circular cross section.

Step 3: So as to place same in standard drum.

Step 4: And seal the same.

There is nothing in the file wrapper history which refutes the idea that the foregoing process was not the one allowed by the Examiner. (Ex. 14-A)

It is true as this Court stated in its previous decision that the material in the reissue application constitutes some evidence in connection with the resolution of the question whether or not the process utilized by the respondent constitutes infringement of the appellant's patent. But this does no mean that the Trial Court should make the decision as to the extent of the claims entirely upon the file wrapper history, as he apparently has done here; thus indirectly applying the doctrine of file wrapper estoppel.

In *Schnitzer vs. California Corrugated Co.*, 140 Fed. 2d 275 (9th Cir. 1944) this Court stated as follows with respect to an issue of infringement p. 276:

"While it is the rule in this Circuit that admissions made by the applicant to the Examiner are not to be used to narrow the scope of his claim unless he has made changes in his application pursuant to the Examiner's suggestions, the proceedings may be used to *aid* in construing the claim." (citing authority)". Again in *Moon v. Cabot Shop Inc.*, 270 Fed. 2d, 539 (9th Cir. 1959) this court again stated at p. 543:

"Claims of a patent must be construed not only in the light of specifications and drawings but also with reference to the file wrapper history * * * a claim must be read and interpreted with claims that have been rejected."

No relevant claim was rejected here by the Examiner (Ex. 14-A).

Of course here as we have pointed out several times, Claim I was allowed by the Examiner in its original form without any modification and upon an explanation that the claim contemplated the compressing of at least one bale of hops into a cross section form so that it could be inserted into any conventional drum and thereby eliminate the necessity of preparing an expensive lead lined box and sealing of same by solder. (Ex. 14-A, p. 17, 18).

It is thus seen that the patent Claim I (Ex. I) when carefully scrutinized in the light of the specifications, in the light of the file wrapper history and in the light of the effect given to file wrapper history by this Court, sets forth a process that is more general than the double drum process illustrated in the specifications.

It is clear from the foregoing that the patented process called for at least one bale which necessarily implied the use of one or more drums. That this was the scope of the claim as contended for by the applicant during the proceedings before the Examiner is apparent from the phrase following the quotation of the court on page 6 of the findings:

“* * * the diameter of which is always uniform so it can readily be used with *any* of the standard drums in the open market.

“Hence, the patent has disclosed a way for the elimination of the known custom built lead lined goods for shipping hops * * *.”

But even if the Examiner felt that the claim was allowable only on the double drum theory (*which he nowhere states in the file wrapper*) the court should be extremely reluctant to base a limitation of the claim upon such a thought or statement of the Examiner. It is only the Examiner's final ruling that can be appealed. Since the original claim was never withdrawn, never modified but allowed in its original terms, there of course could be no appeal. So far as we are aware, there is no appeal from any comment of an Examiner as to the scope of the claim if the claim is allowed in its original terms. To base, at this time, a limitation on the claim upon some comment on the Examiner from which there can be no appeal does not seem to be a sound proposition of law. It is for this reason undoubtedly that this court in *Schnitzer* indicated that admissions made by the applicant to the Examiner are not to be used to narrow the scope of its claim unless he makes a change in his application pursuant to Examiner's suggestion.

Thus, it becomes evident that the scope of Claim I of the patent (Ex. 1), covers and includes the respondent's process; and therefore, there is infringement.

II.

Prior Art

The prior art cited in the file wrapper history, Passarelli U.S. Patent No. 754, 340 (Ex. 60); Schoonmaker U.S. Patent No. 75,203 (Ex. 57); Schoonmaker U.S. Patent No. 77,768 (Ex. 56); and the patents cited

by the respondent here during the trial; Munford Patent No. 672,282 (Ex. 59); Howcott Patent No. 1,418,441 (Ex. 73), and the two texts, Hind, 1948 (Ex. 40) and Gross 1900 (Ex. 41) all teach as pointed out by the Examiner that there is nothing new in compressing rectangular materials into circular forms and there is nothing new in putting materials into tin cans; but that of course does not come to grips with the problem here. It is, we think, extremely significant that not one of these citations discloses and not one of these cited patents solve the problem nor indeed were they intended to solve the problem solved by the Meisler patent.

It will be remembered from the first hearing that the export phase of the hop industry was extremely limited due to the fact that it was necessary to build rectangular boxes, line them with lead or copper, insert the bale and seal it by hand soldering, obviously a very expensive process. As pointed out in the trial court's findings, hops are a very sensitive product (R. 70).

After they are exposed to air they lose their value to brewers (R. 70).

Furthermore, when they are shipped overseas in the original baled form wrapped in burlap as they come from the farm they pick up deleterious odors rendering them unfit for the brewery operation. Mr. George Gannon, a banker and successful hop grower in the Yakima Valley stated very clearly that there was no doubt about the fact that the Meisler invention was successful and opened up foreign markets and that many efforts had

been made to accomplish the results achieved by the Meisler invention; and that not only lead and copper boxes, but plastic and paper bags, were tried *without success* (R. 158, et seq., prior case). At the time of the trial substantial quantities of bales shipped abroad, which now amounts to a substantial percentage of the entire market, utilized the Meisler process; namely, taking “*at least one bale,*” recompressing said at least one bale into circular cross section (step 2) so as to place same into “any” standard drum (step 3) and sealing the same (step 4). How can it be said that unsuccessful methods and devices leave a narrow “crevasse” into which plaintiff’s patent fits? The trial court said:

the plaintiff argues for a liberal condition of the patent but * * * the * * * crevasse into which plaintiff’s patent fits is quite narrow indeed. The exact scope calls for a narrow rather than a broad view.” (R. 72)

This is hardly a sound statement owing to the fact that the inventional ancestors failed to solve the problem with which the hop industry was faced.

The patents cited (Exs. 56-62 & 73) are in non-analogous art and, therefore, cannot be said to be inventional ancestors, since it was not obvious to one skilled in the art of packaging hops to know the manner or the method in packaging cigars or false teeth. Otherwise, why was the industry over 40 years in coming upon this simple solution to its problems?

Judge Learned Hand clearly analyzed this phase of the problem here in two cases written by him for the

2nd Circuit, *Rover v. I. Leon Co.*, 285 Fed. 2d, 501 (1960) and *Norman v. Lawrence*, 285 Fed. 2d 505 (1960). In the former case he stated at p. 503:

“It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a ‘combination’: that is to say, it consists of former elements in a new assemblage. All the constituents may be old, if their new course would not ‘have been obvious at the time the invention was made to a person having ordinary skill in the art’” (§ 103, Title 35). That has been the statutory definition since January 1, 1953. We discussed the question at length in *Lyon v. Bausch & Lomb Optical Co.*, 2 Cir., 224 F. 2d 530, and have little to add to what we then said. * * *

The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person ‘having ordinary skill’ in an ‘art’ with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, ‘obvious’ is to substantiate our ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some sign posts: e.g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant? In the case at bar the answers to these questions all favor the conclusion that it demanded more intuition than was possessed by the ‘ordinary’ workers in the field. The needs were known, but the purpose to fulfill them with that minimum of material and labor disclosed in the patent had not appeared * * *

which is the situation here in the case at bar.

Again Judge Learned Hand in *Norman v. Lawrence*, 285 Fed. 2d p. 506 stated:

“The invention therefore consisted of combining a kind of “pocket” that could be easily slipped on and off the clamp, with the old pad into a single member that would hold the earring in place upon the lobe of the wearer’s ear.

In spite of the fact that this combination was of the simplest sort, made of two elements that had for many years been used in the industry, no one had thought of combining them. Hence it is argued, as it always is when an invention consists of a combination of old elements, there there can be no “invention” in mere “aggregation.” In the case at bar the judge had found that “the commercial success was phenomenal, and again there is no reason to hold that this finding was “clearly” erroneous. * * * We can only reply that, while the standard remains what it is, we can see no escape from measuring invention in cases where all the elements of the new combination had been long available, (1) by whether the need had long existed and been desired, and (2) whether, when it was eventually contrived, it was widely exploited as a substitute for what had gone before.”

Here the need has existed for over 40 years—hence all other efforts to meet the need or solve the problem, met with failure and were entirely unsuccessful until the Meisler invention. (R. 158 et seq., prior case) Indeed, even the respondent did not use this process until respondent learned from one of appellant’s licensees how the process operated. (R. 174, prior case) All in the industry are utilizing the appellant’s process. Some are paying royalties, but respondent is not. None used the process until patented by Meisler. If the test laid down by Justice Learned Hand is sound, clearly that

test has been met here. Thus the patent of the plaintiff, contrary to the Trial Court's statement, is not narrow. A broader construction is desirable in view of the patent's lack of inventional ancestors successful in this field.

At this point it is in order to point out that the questions here involved are not questions of fact but of law. It is a well-established principle that the construction of a claim in a patent is a matter of law for the court to determine. In a recent case in this circuit (*Del Francia v. Stanthony Corporation*, 278 F. 2d 745) this court stated:

"The general rules of patent claims construction are well settled. A patent is to be construed as a contract, with the intent of the parties uppermost so as to give effect to their legitimate expectations. Further, since letters patent are contracts, questions of construction are questions of law for the court."

The Eighth Circuit has also adopted the same rule. In *Solomon v. Renstrom*, 150 F. 2d 805, the court stated:

"The interpretation of the claims of a patent is not to be determined by the opinion of experts, but is a question of law for the court. [Citing authority] The additional evidence was therefore simply advisory."

To the same effect see *Williams Mfg. Co. v. United Shoe Machinery Corporation*, 121 F. 2d 273, affirmed in 316 U. S. 364. See also *Singer Company v. Cramer*, 192 U. S. 265:

"* * * the question of infringement or no infringement is one of law and susceptible of determination on this writ of error."

Therefore, this Court should reverse and enter judgment of infringement and a decree calling for an accounting and assessment of damages.

III

Limitations Upon the Claim—Equivalency

It is evident from what has been said before that since the essential steps of the process claimed in Claim I of the Patent Exhibit I are included in the process utilized by the respondent, there is infringement.

That the specifications of the patent advert to two drums is not a limitation. In *re Vicher*, 141 Fed. 2d, 522, the Court of Customs and Patent Appeals in 1944 laid down this rule which has never been modified or reversed. The statute requires a patentee to explain the principle of his invention in "the best mode in which he has intended applying that principle." The fact that he illustrates one method does not limit the patent to that specific mode. The Court in that case stated on page 526:

"In construing that section, the Supreme Court of the United States in the case of *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U.S. 405, 418, 28 S. Ct. 748, 751, 52 L. Ed. 1122, stated:

"An inventor must describe what he conceives to be the best mode, but he is not confined to that. *If this were not so most patents would be of little worth.* 'The principle of the invention is a unit, and invariable; the modes of its embodiment in a concrete invention may be numerous and in appearance very different from each other.' 2 Robinson, Patent, §485." (Italics not quoted.)

* * *

Obviously, the decision of the Board of Appeals,

as well as that of the Primary Examiner, is not in accordance with the rule as stated in the solicitor's brief, that is, "that ordinarily in a mechanical case broad claims may be supported by a disclosure of a single form of the apparatus disclosed in an application." Nor is the board's decision in conformity with the statement contained therein that "in a mechanical case an applicant may generally draw a broad claim on a single construction."

In mechanical cases, such as that here involved, broad claims may be supported by a single form of apparatus disclosed in an applicant's application. See *In re Kirschbraun*, *supra*, and cases therein cited; *Ex parte Kleinknecht*, 49 U.S.P.Q. 680; *Ex parte Vickers*, *supra*.

For the reasons stated, we are of opinion that the appealed claims were improperly rejected. Accordingly, the decision of the Board of Appeals is reversed."

So here the fact that two drums are mentioned obviously does not exclude a single drum application. As stated in the file wrapper, the Examiner's comment

"It is immaterial what shape the hops are pressed into and whether or not it is sealed *in the center or the end* * * *"

and in the patent attorney's remark:

"The Examiner is further requested to reconsider the statement that it is immaterial into what shape the hops are pressed into since an important part of applicant's invention is to be found in the fact that two ordinary rectangular bales of hops are pressed into a single bale, the diameter of which is always uniform so that it can be used with *any* of the steel drums found in the open market." (Ex. 14A, pp. 17, 18)

"Applicant has disclosed the need for the elimination of the known custom built metal lined boxes for shipping hops."

It is apparent that at the time of consideration of the allowance of Claim I, *the issue did not turn upon whether one or two drums were used*. The essence was to be found in the change in the shape, thereby permitting the use of *any* standard drum, and ease of sealing.

So far as the respondent's methods are concerned, the four essential steps of the Meisler Patent are utilized by the process and infringement does exist. The principle of taking the standard Western farm hop bale (already compressed at the farm) rectangular in shape and re-compress it into a circular form to fit into a standard drum and sealing is identical. This is the essential idea of applicant Meisler's patent. Indeed, at the close of the first trial after the court had gone to the warehouse of both parties and had demonstrated for him what was being done by Meisler and what was being done by respondent, the trial court stated:

“* * * Were we to interpret the original patent as issued without reference to the reissue application it might be permissible to construe Claim I as reading upon the accused packaging now used by defendant * * * by failing to appeal (rather than withdraw the reissue application) * * * plaintiff in my judgment may not now contend that the claims of the original applicant and patent are susceptible to an interpretation that they cover single drum containers as well as two drum containers. The doctrine of file wrapper estoppel seems applicable and controlling.”

But, of course, the doctrine of file wrapper estoppel is no longer applicable in this case by reason of the prior decision of this court. It would seem that the first im-

pression of the trial court, after consideration of all the patents now cited and all of the history now cited (i.e. all of the prior art) and having freshly examined the operations of Meisler and respondent was a sounder opinion than the one expressed in the finding which, of course was the one proposed by the respondent.

In his interrogation of the witness George Gannon, the cross examiner obtained the following:

“Q. And in your view of it, all Mr. Meisler did then was to recompress the bale into circular shape to put it in a circular drum or container?”

A. Yes.”

Likewise the court made the same point:

“THE COURT: So that the advantage of the packing is that it utilizes an available container, namely, the drum?”

THE WITNESS: That is right.” (R. 163, prior case)

Furthermore, it is established law that where the invention, as in the case at bar, pertains to the process or method, here the process of recompressing bales of hops into a circular form and placing the same in “an available container namely the drum”—such patent is infringed even though the infringing method be carried out in a different number of steps and with different methods. As quoted above in Vicker, (141 F. 2d 522) broad claims may be supported by a single form disclosed in an applicant’s application. The landmark case of *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U. S. 605, 85 USPQ, 328, is directly in point. There the court stated on page 331:

“But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make *unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law*. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.”

It is clear from the foregoing that the use of a single drum is merely another illustration or equivalent of the use of two drums bearing in mind that the essential idea of the patent as established by opposing counsel as well as by the Trial Court on his examination of the witness is the simple four step idea as stated above:

Step 1: The recompressing of at least one standard bale.

Step 2: Into circular cross section.

Step 3: So as to place same in standard drum.

Step 4: And seal the same.

The two drum illustration or application of this idea was, therefore, merely illustrative and not limiting. It is of significance that it would be a virtual economic impossibility for the growers in Western states, which

produce substantially all hops produced in the United States, in the first instance to bale their hops in a circular form since all of the growers' equipment would have to be abandoned and new equipment installed (R. 62, 63, prior case). A particular process once adopted in an industry cannot be uprooted without great damage and loss. Therefore, the inventor's idea here is not narrow nor does it fit into a narrow crevice as it existed in the hop industry at the time of its conception and the time of the application for the patent Exhibit 1.

The thought underlying the Trial Court's final decision in this case appears to be that the respondent's process is materially different from the appellant's process because it is a net weight process. When the bale is cut in two, although there is substantial wastage, therefore making the respondent's operation inefficient as compared to appellant's method, the loose hops can be added or taken away and thereby a net weight obtained.

This, of course, can be done by appellant's method of selecting bales to give the required weight and, therefore, this added feature is not inventive but even if it be inventive, it does not defeat the charge that the invention caused the respondent to utilize the four essential steps of appellant's Claim I of appellant's patent stated above. For example, at one time the fountain pen was or could have been the subject of a patent (even though it was contained in a single or double base). Someone added a clip so that it could be inserted in a

shirt pocket. This addition of the clip may or may not have been inventive at the time. But the use of the pen would, of course, infringe the original patent with or without the added clip. Thus, the addition of an element which may or may not be inventive does not limit the claim or defeat the charge of infringement.

In other words, the charge of infringement is not voided by adding another step to the process, when the steps of the patent in question are utilized and the result obtained by such use. So here, the mere fact that the bale is cut in two and an added feature of the control of the net weight of the packaging does not alleviate the infringement. In this connection, of course, the doctrine of equivalency is important and it is our contention that the operation of the respondent and the process claimed in Claim I of appellant's Patent Exhibit 1 are equivalent within the meaning of the law.

In the early work, "The Law of Patents," Vol. 1 by William C. Robinson, it is stated, page 337:

"An equivalent is therefore any act or substance which is known in the arts as a proper substitute for some other act or substance employed already as an element in an invention, and whose substitution for that other act or substance does not in any manner vary the idea of means."

In that treatise the idea contended for here that a process performing an additional function is nevertheless an infringement of the original patented process is recognized. The author stated, p. 340 and 341:

"Again, equivalence is not affected by the fact that the new element performs in the invention

some function in addition to the old. While it is necessary that the entire service rendered by the act or substance, whose place another occupies, should be discouraged, it is not essential that the operation of the substitute should be confined within the same limits as the former. It is sufficient that it serves the same use; if it serves others also, or better serves the old, it is no less an equivalent than if the entire functions of each, as elements in the invention, were identical. One act or substance may thus be the equivalent of another, although the latter, if the former had been first employed, could not have been regarded by itself alone as its complete and perfect substitute in the invention. Yet as to the one use which both alike subserve, they stand on the same footing as if no other use were possible to either, and as to that are interchangeable equivalents."

To the same effect is *Highway Appliances Co. v. American Concrete Expansion Joint Co.*, 93 Fed 2, 113. There the 7th Circuit held as follows, page 118:

"Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape, *Union Paper Bag Machine Vo. v. Murphy*, 97 U.S. 120, 125, 24 L. Ed. 935. And see *Elizabeth v. Pavement Co.*, 97 U.S. 126, 137, 24 L. Ed. 1000. That mere colorable departures from the patented device do not avoid infringement, see *McCormick v. Talbott*, 20 How. 402, 405, 15 L. E. 930. A close copy which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement.

"* * * The improvements, however, in each instance, were merely the result of applying such

knowledge and training, as might be expected of those familiar with such problems, to the structure described and claimed in the Older patent. In *Farrington v. Haywood* (C.C.A.) 35 F. 2d 628, on page 631, it is said: 'Doubtless the defendant's stirrer has some functions not possessed by the plaintiff's, and it may be under some conditions an improvement thereon, but this fact also does not avoid infringement. *Gordon Form Lathe Co. v. Walcott Machine Co.* (C.C.A.) 32 F. 2d 55'."

See also, *Waterproof Insulation Corp. v. Insulating Con. Corp.*, 153 Fed. Supp. 626, where the court said, page 631:

"Wicor is the equivalent of the Goff system. Plaintiff urges that as rubber was not, at the time the Goff patent issued, known as an interchangeable ingredient, it cannot be held to be an equivalent. Again, this ignores the fact that the Goff patent, as distinguished from the Bell patent, is for a system, not a "construction material." Moreover, infringement is not avoided by the fact that a patented combination has been improved by the substitution of a new element which in itself may be the basis for a patent. *Frick v. Lindsay*, 4 Cir., 1928, 27 F. 2d 59, 63; *Wine Ry Appliance Co. v. Baltimore & Ohio R. Co.*, 4 Cir., 1935, 78 F. 2d 312, 316; *Ackermans v. General Motors Corporation*, 4 Cir., 1953, 202 F. 2d 642, 646, certiorari denied 345 U. S. 996; 73 S. Ct. 1139, 97 L. Ed. 1403, rehearing denied 348 U.S. 842, 74 S. Ct. 16, 98 L. Ed. 362; *Temco Electric Motor Company v. Apco Manufacturing Co.*, 1927, 275 U.S. 319, 328, 48 S. Ct. 170, 72 L. Ed. 298; *Finkelstein v. S. H. Kress & Co.*, 2 Cir., 1940, 113 F. 2d 431, 422."

In a recent case decided by this court, Justice Jertberg in writing the opinion in *Hansen v. Colliver*, 282 Fed. 2d. 56, was confronted with the use of the word "guide" in the claim. The defendant seeking to escape

a charge of infringement had used a "table top" in lieu of a "guide" in connection with the means of interchanging cores in wire rope. Justice Jertberg stated as follows, page 69:

"In our view the proper construction of claim 1 requires a "guide" but does not require a guide of any specified shape or form or that the rope shall be guided by any particular means. While we are inclined to disagree with the view of the district court that the table top of the appellees' device is not a guide and therefore does not literally infringe appellant's patent, we are wholly satisfied that the undisputed facts compel the application to this case of the doctrine of equivalents. The doctrine is applicable if the accused device performs substantially the same function in substantially the same way to obtain the same result as that claimed for the patented device. *Sanitary Refrigerator Co. v. Winters*, 1929, 280 U.S. 30, 42, 50 S. Ct. 9, 74 L. Ed. 147; *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 1950, 339 U.S. 605, 70 S. Ct. 854, 94 L. Ed. 1097.

Normally, the question of infringement is one of fact. In this case, however, since the facts are not in dispute the question of infringement resolves itself into one of law, depending on a comparison between the patent claim in issue and the accused device, and the correct application thereto of the law of equivalency. *Kemart Corp. v. Printing Arts Research Laboratories*, 9 Cir., 1953, 201 F. 2d 624; *Del Francia v. Stanthony Corp.*, 9 Cir., 1960, 278 F. 2d 745. See also *United States v. Parke, Davis & Co.*, 1960, 362 U.S. 29, 80 S. Ct. 503, 4 L. Ed. 2d 505.

* * *

In our view the accused device performs substantially the same function in substantially the same way and obtains the same results as are embraced in claim 1 of the patent. It may be, as indicated by the trial court, that appellees' device is superior in its simplicity in the use of a table top instead of a guide. If the table top is an improvement it is never-

less the equivalent of the guide and is merely a change in form. As stated by the district court in its memorandum opinion:

“A claim, however, does not limit the patentee to the exact mechanism described, leaving the public at liberty to construct substantially identical copies of the patented machine by varying its form or proportions (White v. Dunbar, 119 U.S. 47, 7 S. Ct. 72, 30 L. Ed. 303), or to adopt mechanical equivalents for the machine or portions thereof (Hobbs v. Beach, 180 U. S. 383, 21 S. Ct. 409, 45 L. Ed. 586).”

Under the facts of this case and the law applicable thereto, the appellant is entitled to a decree that the appellees' device infringes his patent, and to the injunctive relief sought. The portion of the judgment appealed from is reversed.”

As stated in the Graver case above cited, a patent becomes a completely useless and void thing and the purpose of the constitutional provision upon which the validity of a patent depends is thwarted if an equivalent such as respondent's process is held not to be an infringement. The claim is thus not limited to the double drum application.

IV

Non-Analogous Art

We wish here to emphasize again that the prior art existing at the time the Meisler application was filed *did not solve*—indeed *did not attempt to solve* the problem the hop industry had, namely, safe and economical means of shipping abroad. As was stated in the specifications of the patent (Ex. 1):

“It is an object of the instant invention to provide better packing which will be impervious to

weather, negligent handling, and poor storing in the holds of ships where other cargoes may contaminate the hops with odors, moisture, acids, etc., the hops being easily damaged.”

Nothing had accomplished the foregoing objective except as stated by Mr. George Gannon lead lined and copper boxes; plastic and paper bags were introduced with no success (R. 158 et seq., prior case). After the Meisler invention came into use, the process was utilized throughout the industry and resulted in the development of a foreign trade which absorbs a substantial percentage of the annual crop, not only making the hop industry as a whole more profitable but adding additional acres of land to hop production, each a worthwhile economic objective. The test laid down by Judge Hand in the cases cited above clearly indicates that the test of non-obviousness has been met.

Against this undoubtedly sound conclusion respondents have heretofore cited several additional patents, some of which were cited by the Examiner and some of which were supplied during the progress of the trial. As was pointed out by the Examiner there is nothing new in taking material and changing its shape from rectangular to circular nor is there anything new in recompressing hops but none of this solved the problem that the hop industry was confronted with as stated above. Specifically, the method disclosed in the Passarelli patent No. 750,350 showed the compression of a rectangular bale of cotton into a circular bale of cotton aiding the hop industry. Likewise the use of a circular

can in which to carry a set of false teeth did not solve the problem. Furthermore, it is a simple device to press finished cigars into a can. The invention required for solution of the problem was not contained in any of the patents cited. They did not purport to solve the shipping problem in the hop industry and further, *they did not do so*. As anticipatory, each of these patents was in a non-analogous field and, therefore, are not pertinent and cannot be used to defeat the claim contended for here.

For example, in the case of *Elrick Rim Company v. Reading Tire Machinery Co.*, 264, Fed. 2d 481 (9th Cir. 1959), this court indicated that development or patent in non-analogous art is not relevant to refute a charge of infringement. In that case the method of spraying liquid rubber cement on tires was not defeated nor was its scope limited by the fact that a similar spray device or method was utilized in the paint industry. In seeking to have the claim limited and declared invalid, the defendant argued that as compared to the prior paint spray art taught by the Shelburne patent Reading cannot be regarded as the invention or discovery of a new and useful process. The same comparison is drawn and assertions made concerning the prior liquid cement art practices by Cahill and Hartman. Justice Hamley stated as follows on p. 486:

“It has already been noted that the Reading process can be utilized by means of the Shelburne, Graddolph, or McLean device, providing certain adjustments or changes are made. This fact alone, how-

ever, is not sufficient to rule out patentability. The term "process" is defined in the patent law as including "a new use of a known process, machine, manufacture, composition of matter, or material." 35 USCA §100(b). * * *

In our view these two variances are sufficient to warrant the conclusion that Reading teaches a nonanalogous art and is therefore a "new" use of a known machine within the meaning of §100(b).

It is true, as appellant argues, that in numerous decisions the rule has been announced that the mere function of a machine is not patentable. But this rule does not apply in the case of a process patent involving the use of a known machine where such use is found to be "new" within the meaning of §100(b), provided the other conditions of patentability are satisfied."

Again, in the case of *King v. Anthony Pools, Inc.*, 202 Fed. Supp. 426, Judge Yankwich was faced with the contention that developments in connection with irrigation practices pertaining to streams and lakes were relevant to a method or device for the handling of water in swimming pools. He stated as follows in finding against the defense, p. 429:

"The defense of anticipation by prior patents is based chiefly on three patents relating to dams and weirs for streams: * * * To apply these patents relating to *streams and lakes* to the small compass of a swimming pool would call for a change in environment and a change in structure, as the defendants' expert, Robert H. Daugherty, readily admitted."

So here development in the field of cigars or cotton could hardly be relevant to patents pertaining to development in the Western hop industry with its special unique problems. Thus the patents and texts cited by

appellant have no relevancy here in narrowing the scope of the claim or defeating the claim of infringement.

V.

Findings of the Trial Court

The findings of the Trial Court in general were drafted by counsel for respondent (both parties submitted findings) and were adopted by the Trial Court. In the findings of fact Nos. referred to above the Trial Court finds that the process set forth in Claim I of Exhibit 1 is related to the use of two drums and the use of two drums is a necessary phase of the appellant's process set forth in Claim I (R. 68).

In the first place it is appellant's contention that these findings in so holding (6-22) are incorrect. As to whether or not the file wrapper of the Patent and its application disclosed the use of one or indeed more than two drums, we call your honor's attention to the fact that the last paragraph of the specifications clearly indicates that there are other methods and means. We repeat that quotation at this point, "it is obvious that the methods illustrated and devices herein are subject to many variations within the scope of the claims. Further, the claim itself, Claim I, refers to the compressing of

"* * * at least *one bale* of hops of rectangular cross section into a *bale* of circular cross section, fastening the bale of circular cross section with spaced flexible members disposed transversely therearound, placing the bale of circular cross section

into two steel drums with the flanges around the open ends thereof superposed, and sealing the superposed flanges on *the drum*."

It would be obvious, we think, to anyone examining Meisler's operation to see that a single drum would be the equivalent and just as easily used as a multiple drum. The language of the claim itself would indicate that a single drum application was contemplated. The reduction in volume described in the specifications of a bale of hops indicates in the event one bale was used, a single drum would be the only proper receptacle. In these findings the court also indicated that there is nothing in the file wrapper history to indicate anything except the use of two drums essential to the process. Such is not the case. The patent attorney in reply to the Examiner indicated that the object was to conform the bale of hops "at least one bale" into a form to fit "*any* of the steel drums found in the open market"—again contemplating a single drum. With respect to the matter of file wrapper as to the reissue application, the Trial Court in its findings adopts as an aid in construing Claim I the language contained in the oath, power of attorney and petition for the reissue, the broad conclusion,

"I claim that my said letters patent is * * * invalid * * * in that the specifications and the short description of the invention does not indicate that the sealing of the bale into two steel drums is an optional procedure." (Ex. 14)

This, of course, is a broad general conclusion based upon the advice of the attorney that the letters patent

were invalid—an ultimate conclusion of law. It would seem that the only material in the oath to aid the construction of the claim would be more specific statements such as the following as to which Mr. Meisler in the oath and petition also swore to:

“* * * the original patent describes my invention as a combination of a method of compressing hops with the step of placing a bale into two steel drums, while actually one steel drum can be used in place of two steel drums *without affecting the scope of my invention.*” (Ex. 14)

It thus appears that the material factual statements in the application for reissue—not the broad conclusions of law—support the contention that the original claim does cover the use of a single drum and that the use of two drums is not an essential element of the process of Claim I of the patent and at the very least is an equivalent. The position of the applicant has been at all times consistent notwithstanding that the Trial Court felt that there was an inconsistency and that it defeated this action for infringement. It was not at all inconsistent to apply for a reissue for had the reissue been granted it would not have meant the original claim did not cover the single drum application but it would have had the advantage to the claimant that he would not have to depend on the doctrine of equivalency in seeking to enforce his patent and protect his invention.

This court should hold that the doctrine of equivalency does apply and that the patent is infringed be-

cause it seems perfectly clear from the foregoing analysis that the defendant's operation does so infringe.

CONCLUSION

In the two recent Supreme Court cases, *Graham v. John Deere Co.* and *U. S. v. Adams*, 383 U. S. 1, the effect of the 1952 act was analyzed and the comment in *Cune v. Automatic Devices Corp.*, 314 U.S. 84, that a patent required a "flash of genius" was relegated to a matter of rhetoric rather than an exact standard of inventiveness. Justice Clark indicated the 1952 statute merely restated and confirmed existing court made law, that in addition to novelty and utilization the invention must be of a nonobvious nature to a person having ordinary skill in the pertinent art. If as true in the case at bar, it takes the industry 40 or 50 years to solve a problem, the solution, no matter how simple in retrospect, was not in fact so obvious to a person having ordinary skill in the pertinent art. As Justice Learned Hand indicated, when there is a long felt need and the invention in question answers the problems successfully and is accepted and utilized by the industry, it cannot be said that the invention is obvious. This is the gist of the holding in the case of *U. S. v. Adams*, 383 U.S. 39. The invention in *Adams* related to a water-activated battery operated with cuprous chloride and magnesium. In that case Justice Clark said,

"* * * it is fundamental that claims are to be construed in the light of the specifications and that they are to be read *with a view to ascertaining the invention.*"

In neither the specifications nor claims was there any reference to any electrolyte. Justice Clark in affirming said:

“The obvious implication from the absence of any mention of electrolytes—a new element in any battery—in the other 8 claims reinforces this conclusion (that water alone can be used).”

The court below held that the Government’s battery had been the equivalent. The Supreme Court of the United States thus holds that the doctrine of equivalency still applies and protects the inventor so he and others will be induced to exercise their ingenuity to the advantage of mankind. The court further said,

“* * * We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness. Nor are these the only factors bearing on the question of obviousness. We have seen that at the time Adams perfected his invention noted experts expressed disbelief in it. Several of the same experts subsequently recognized the significance of the Adams invention, *some even patenting improvements on the same system.*”

If the purpose of the constitutional provisions establishing the right of Congress to provide for patents and if inventor is to be rewarded by giving to him part, at least, of the profits from the use of his invention and if, as the Constitution indicates, it is a worthwhile objective of our Government to grant patents so as to “serve to incite ingenuity,” then it would appear that infringement should be found here.

The history of the industry, the history of this pat-

ent, the history of the operation of respondent clearly indicate that to hold otherwise is to destroy rather than to enhance the invitation to ingenuity called for by the Constitution.

It is respectfully submitted that the Trial Court should be reversed and the respondent should be ordered to account for his profits and other damages prayed for in appellant's complaint.

Respectfully submitted,

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CERTIFICATE

I hereby certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

Attorney

